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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/318,353	05/25/1999	CHARLES L. CASAGRANDE	38916/14140	1317

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/318,353

Applicant(s)
Charles Casagrande

Examiner
Mark Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 22, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-23, and 25-28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-28 is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 2, 12 and 15 have been amended for further examination. Claims 25-28 have been added. Claims 11 and 24 have been canceled.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-7, 9, 11, 12, 14, 16-18, 23 and 24 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al (5,662,976) in view of Ashby et al (4,876,131).

Popat et al discloses in Fig. 4 and 7, a form with integrated label comprising a form layer (60) having a top surface (A) and a bottom surface (62) and a periphery, at least one die cut (68 and 70) through the top and bottom surfaces within the periphery of the form layer defining at least one portion (portion of 60 between 68 and 70) or card intermediate, a patch layer (80) divided by a perforation line (82), a periphery and composed of translucent material, top surfaces (80a) and bottom surface (80b), a layer of repositionable, peelable adhesive (58), wherein the bottom surface of the patch layer is adhesively but removably secured (due to release coating 64) to the top surface of the form layer over the entire die cut and form layer portion in which the patch layer, adhesive layer and form layer comprising an integrated label (as seen in Fig. 7) and wherein the adhesive layer has a greater affinity for the bottom surface of the patch layer than the top surface of the form layer such that when the label (as seen in Fig. 7) is removed from the

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form, the portion of the adhesive layer (portion on left side of die cut 72 and left side of 68 as seen in Fig. 4) that is not between the patch layer and the form layer portion (portion of 60 between 68 and 70) is exposed and stays adhered to the bottom surface of the patch layer (this can also be seen in Fig. 3, top portion wherein when the label is lifted, the exposed adhesive can be seen around the die-cut perimeter). Popat also discloses a patch layer sized and offset in relation to the die cut in the form layer such that a distance between an edge (76A) of the patch layer and a corresponding edge of the form layer (70A) is greater than that between other corresponding edges.

However, Popat et al does not disclose: wherein the form and label are void of releasing agents; a patch layer composed of translucent paper glassine, translucent polyester film, opaque material; sized and offset in relation to the die cut in the form layer such that the distance between an edge of the patch layer and a corresponding edge of the form layer portion is less than that between other corresponding edges; the form layer contains multiple die cuts therein defining multiple portions of the form layer.

Ashby et al discloses in Fig. 1, a form (12) and integrated label (14) having no releasing agents (Col. 2, lines 13-23, and Col.4, lines 23-34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Popat's form to incorporate a form and integrated label having no release agents between substrate and adhesive as taught by Ashby et al for the purpose of avoiding paper wastage caused by release agent.

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In regards to **Claims 1 and 12**, it would have been an obvious matter of design choice to construct a peelable label having a pressure sensitive adhesive attached to a release coating to make it removably attachable instead of the use of a repositionable material adhesive void of any release coatings, since applicant has not disclosed in the claims that the repositionable adhesive solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a pressure sensitive adhesive removable attached to a release coating on a form layer. Furthermore, it is noted that the features upon which applicant relies (i.e., a form void of releasing agents allowing for recycling of the form) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regards to **Claims 4-6, 17, 18**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the patch layer in any desirable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Furthermore in regards to **Claim 6 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to offset the patch layer and form layer at any distance, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

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Also in regards to **Claims 6 and 7**, it would have been an obvious matter of design choice to construct the patch layer in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

In regards to **Claim 9 and 23**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any number of die cuts, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

3. Claims 2, 10, 15, 21, 22, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al in view Ashby et al and further in view of Blum et al (4,204,706).

Popat et al as modified by Ashby et al discloses a form with integrated label comprising all the elements as claimed in Claim 1, 11 and 12 and as set forth above. Popat et al also discloses the bottom surface (62) of the form layer being able to accept indicia.

However, Popat et al and Ashby et al do not disclose the top surface of the patch layer and the top surface of the form layer being able to accept indicia.

Blum et al discloses in Fig. 2 and Col. 3, lines 50-56, a form with integrated label having a patch layer (19) and a form layer (17) in which indicia can be accepted on the top surfaces thereof through the use of "spot carbonized" method, so that when marking pressure is applied to the

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outer top surface of the patch layer, a corresponding ink mark is produced on the top surface of the form layer.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Popat et al's and Ashby et al's form to include "spot carbonization as taught by Blum et al for the purpose of eliminating the requirement that the patch be folded back to permit marking of indicia on the form surface.

4. Claim 8, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al in view of Ashby et al and further in view of Stipek (3,914,483).

Popat et al as modified by Ashby et al discloses a form with integrated label comprising all the elements as claimed in Claim 1 and as set forth above.

However, Popat et al and Ashby et al do not disclose an integrated label containing a second label comprising portions of the patch within a second die cut extending through the patch layer and to, but not through the form layer portion, wherein the second label is removable.

Stipek discloses in Fig. 5 and 6, an integrated label (51) containing a second label (33) comprising portions of the patch and adhesive layers within a second die cut (53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Popat et al's and Ashby et al's form to include a label within a label as taught by Stipek for the providing a way in which an inner label can be removed from the

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main label after it is affixed to a container with the inner label being easily attachable to containers.

Allowable Subject Matter

5. Claims 25-28 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses or teaches a form with an integrated fold over card comprising: a form layer having top and bottom surfaces and a periphery; a first and second die cut and through the top and bottom surfaces of the form layer defining a first and second portion within the die-cut; a patch layer having first and second halves, a periphery and top and bottom surfaces; a layer of repositionable peelable adhesive; the patch layer, adhesive layer and two form layer portions comprising the fold-over card intermediate; wherein once removed from the form layer, the fold-over card intermediate can be folded in half enclosing the first and second form layer portions between the folded halves of the patch; and wherein the die cut is of a size and shape to make the area of the exposed adhesive of sufficient size and shape such that an article placed in or over the area can be viewed through the area and the patch layer; and including all of the other limitations of the independent and dependent claims.

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Response to Arguments

7. Applicant's arguments filed on March 22, 2002 have been fully considered but they are not persuasive.

In response to applicant's argument that the applicant's invention is patentably distinguishable over the Popat et al reference by disclosing the limitation that the "form and integrated label are void of releasing agents", the examiner submits that Popat et al in view of Ashby discloses an integrated form void of releasing agents (as stated in Col. 2, lines 13-22). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Popat's form to incorporate a form and integrated label having no release agents between substrate and adhesive as taught by Ashby et al for the purpose of avoiding paper wastage caused by release agent.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

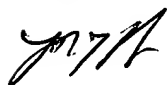
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

May 31, 2002



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